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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,972	10/02/2003	Pierre Ducray	H-31706B	9064

1095 7590 08/17/2005

NOVARTIS  
CORPORATE INTELLECTUAL PROPERTY  
ONE HEALTH PLAZA 104/3  
EAST HANOVER, NJ 07936-1080

EXAMINER
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SACKEY, EBENEZER O

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/677,972

**Applicant(s)**

DUCRAY ET AL.

**Examiner**

EBENEZER SACKY

**Art Unit**

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/02/03.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### **Status of Claims**

Claims 1-11 have been cancelled.

Claims 12-17 are pending.

### ***Specification***

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

Art Unit: 1626

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 12-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, of U.S. Patent No. 6,239,077 ('077'). Although the conflicting claims are not identical, they are not patentably distinct from each other because there is considerable overlap between the instant claims and claims in '077'. The instant application discloses for the same purpose compositions, which are similar to compositions of '077' for controlling pests.

Claim 15 is drawn to compositions containing specific species, which are obvious variants of compositions embraced by the genus of prior '077'. See for example composition containing compound species N-[1-(4-Chlorophenoxy)-2-cyanoprop-2-yl]-2-(2-chlorophenyl)-N-butylacetamide, a compound under the genus of formula (I), claim 1 where  $Ar_1$  and  $Ar_2$  are substituted phenyl, (Q)<sub>d</sub> is CH<sub>2</sub>, W is O, b is 0 and R<sup>3</sup> is butane. Thus, claims in '077' are broader in scope than claims in instant application. Hence, the genus is rendered obvious by the species.

Therefore, the instantly claimed composition is taught by '077' and would have been suggested to one of ordinary skill in the art.

Note that the agricultural and horticultural insecticide containing the aminoacetonitrile derivative of formula (I) is suitable for controlling various pests in agriculture, forestry, horticulture, stored products as well as sanitary vermin or nematoda. Also note that '077' does not disclose any enantiomer of structural formula

Art Unit: 1626

(I). However, it is well settled that an enantiomer, stereoisomer is not patentable over its known racemic mixture unless it possess unexpected properties not possessed by the racemic mixture. *In re Anthony*, 162 USPQ 594, 596 (1969) and *In re Adamson*, 125 USPQ 233, 234 (1960).

The motivation to make the claimed composition derives from the expectation that the compositions generically described by '077' would be reasonably expected to exhibit similar pesticidal properties. Thus, it would have been obvious to one skilled in the art at the time the invention was made to have a reasonable expectation that the claimed compositions would also be useful for controlling pests in view of the close structural similarities outlined above. Therefore, the instantly claimed compounds would have been suggested to one of ordinary skill in the art absent a showing of unobvious or unexpected properties and/or results.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1626

Claims 12-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6-11 of copending Application No. 10/466,824 ('824').

Although the conflicting claims are not identical, they are not patentably distinct from each other because there is considerable overlap between the instant claims and claims in pending "824". The instant application discloses for the same purpose compositions, which are similar to compositions of '824' for controlling same pests.

Claim 15 is drawn to compositions containing specific species, which are obvious variants of compositions embraced by the genus of pending '824'. See for example composition containing compound species N-[1-(4-Chlorophenoxy)-2-cyanoprop-2-yl]-2-(2-chlorophenyl)-N-butylacetamide, a compound under the genus of formula (I), claim 6 where  $Ar_1$  and  $Ar_2$  are substituted phenyl, (Q)<sub>d</sub> is CH<sub>2</sub>, W is O, b is 0 and R<sup>3</sup> is butane. Thus, claims in pending '824' are broader in scope than claims in instant application. Hence, the genus is rendered obvious by the species.

Therefore, the instantly claimed composition is taught by '824' and would have been suggested to one of ordinary skill in the art.

Note that the agricultural and horticultural insecticide containing the aminoacetonitrile derivative of formula (I) is suitable for controlling the same pests.

The motivation to make the claimed composition derives from the expectation that the compositions generically described by '824' would be reasonably expected to exhibit similar pesticidal properties. Thus, it would have been obvious to one skilled in the art at the time the invention was made to have a reasonable expectation that the

Art Unit: 1626

claimed compositions would also be useful for controlling pests in view of the close structural similarities outlined above. Therefore, the instantly claimed compounds would have been suggested to one of ordinary skill in the art absent a showing of unobvious or unexpected properties and/or results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (571) 272-0704.

The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

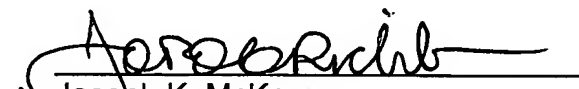
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is

(571) 272-1600.

EOS

August 5, 2005

  
Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626, Group 1600  
Technology Center 1